



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,519	04/26/2000	Peter V. Boesen M.D.	P04179US0	9687
22885	7590	03/14/2006	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C.			PASS, NATALIE	
801 GRAND AVENUE			ART UNIT	
SUITE 3200			PAPER NUMBER	
DES MOINES, IA 50309-2721			3626	

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/558,519

Applicant(s)

BOESEN M.D., PETER V.

Examiner

Natalie A. Pass

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 84-89,92-100,102 and 103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 84-89,92-100,102 and 103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>26 October 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the response filed 20 December 2005. Claims 84 and 92 have been amended. Claims 1-83, 90-91, 101 and 104 have been cancelled. Claims 85-89, 93-100, 102-103 have been previously presented. The IDS submitted 26 October 2005 has been entered and considered. Grounds of rejection for claims 84-89, 92-100, and 102-103 are presented in the instant application as set forth in detail below.

Specification

2. The objection to the specification under 35 U.S.C. 132 for introducing new matter is hereby withdrawn due to the amendment filed 20 December 2005.

Claim Rejections - 35 USC § 112

3. The rejection of claims 84-89, 92-100, 102-103 under 35 U.S.C. 112, first paragraph is hereby withdrawn due to the amendment filed 20 December 2005.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3626

5. Claims 84, 88-89, 94-100, 102-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waters et al., U.S. Patent Number 6, 393, 404 in view of Dorne, U.S. Patent Number 5, 325, 293 for substantially the same reasons given in the previous Office Action (paper number 09072005). Further reasons appear hereinbelow.

(A) Claim 84 has been amended to include the recitation of

- ♦ “the patient procedure code associated with a procedure performed on a patient during a patient encounter” in lines 2-3;
- ♦ “the at least one diagnosis code associated with at least one diagnosis of the patient performed during the patient encounter” in lines 4-6; and
- ♦ “to thereby document the patient encounter” in line 11.

As per newly amended claim 84, Waters and Dorne disclose a method for providing medical coding, further comprising:

the patient procedure code associated with a procedure performed on a patient during a patient encounter (Dorne; column 4, lines 58-63, column 11, lines 30-32);

the at least one diagnosis code associated with at least one diagnosis of the patient performed during the patient encounter (Dorne; column 16, lines 9-19); and

to thereby document the patient encounter (Dorne; column 16, lines 20-21, 48-61).

The remainder of claim 84 is rejected for the same reasons given in the prior Office Action (paper number 09072005, section 10, pages 5-7), and incorporated herein.

The motivations for combining the respective teachings of Waters and Dorne are as given in the rejection of claim 84 in the prior Office Action (paper number 09072005) and incorporated herein.

Art Unit: 3626

(B) Claims 88-89, 94-100, 102-103 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 09072005, section 10, pages 7-9), and incorporated herein.

6. Claims 85-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waters et al., U.S. Patent Number 6, 393, 404 and Dorne, U.S. Patent Number 5, 325, 293, as applied to claim 84 above, and further in view of Lavin et al, Pat. No. 5,772,585 for substantially the same reasons given in the previous Office Action (paper number 09072005). Further reasons appear hereinbelow.

(A) Claims 85-87 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 09072005, section 11, pages 9-11), and incorporated herein.

7. Claim 92 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guadagnino, Christopher, "Documentation and coding tools" (hereinafter Guadagnino) and Dorne, U.S. Patent Number 5, 325, 293 for substantially the same reasons given in the previous Office Action (paper number 09072005). Further reasons appear hereinbelow.

(A) Claim 92 has been amended to include the recitation of

- ♦ "to thereby provide a record of a patient encounter" in line 7.

As per this new limitation, Guadagnino and Dorne discloses a method further comprising:

Art Unit: 3626

to thereby provide a record of a patient encounter (Dorne; column 16, lines 20-21, 48-61).

The remainder of claim 92 is rejected for the same reasons given in the prior Office Action (paper number 09072005, section 12, pages 11-12), and incorporated herein.

The motivations for combining the respective teachings of Guadagnino and Dorne are as given in the rejection of claim 92 in the prior Office Action (paper number 09072005) and incorporated herein.

8. Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guadagnino, Christopher, "Documentation and coding tools" (hereinafter Guadagnino) and Dorne, U.S. Patent Number 5, 325, 293, as applied to claim 92 above, and further in view of Lavin, for substantially the same reasons given in the previous Office Action (paper number 082004). Further reasons appear hereinbelow.

(A) Claim 93 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 09072005, section 13, page 13), and incorporated herein.

Response to Arguments

9. Applicant's arguments filed 20 December 2005 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 20 December 2005.

(A) At pages 6-8 of the 20 December 2005 response, Applicant identifies the location of material in the specification that was objected to under 35 U.S.C. 132 as "new matter."

Art Unit: 3626

Examiner thanks applicant for identifying this feature, and has consequently withdrawn both the objection and the rejection under 35 U.S.C. 112, first paragraph.

At pages 8-10 of the 20 December 2005 response, Applicant argues that the newly added features in the 20 December 2005 amendment are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references, including the features newly added in the 20 December 2005 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the teachings of Waters, Dorne, Lavin, and Guadagnino, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 09072005), and incorporated herein. In particular, Examiner notes that a patient procedure code associated with a procedure performed on a patient during a patient encounter, and at least one diagnosis code associated with at least one diagnosis of the patient performed during the patient encounter and thereby documenting the patient encounter are taught by the applied references. Specifically, Examiner interprets Dorne's teachings of

“the user enters the procedures that were involved during the patient examination. Specifically, the user selects between the major procedural categories ... [...] ... the interactive program receives the user's selection ... [...] ... and proceeds to an activity block 244 where the interactive program receives the user's selection of the specific procedural category ...” (Dorne; column 11, lines 30-39)

as teaching a “receiving ... patient procedure code associated with a procedure performed on a patient during a patient encounter;” and Examiner interprets Dorne's teachings of

Art Unit: 3626

“[t]he interactive program preferably also has the capability of keeping track of the ICD-9 diagnostic codes most likely associated with the procedures selected by the user.

Specifically, after sorting the final code system variable, the interactive program proceeds to an activity block 372 and recalls from memory all of the likely ICD-9 codes associated with the procedures that the user has selected” (Dorne; column 16, lines 9-19)

as teaching “receiving ...at least one diagnosis code associated with at least one diagnosis of the patient performed during the patient encounter;” and Examiner interprets Dorne’s teachings of

“[a]dvantageously, the interactive program stores all the information required to recall each examination screen of a particular record. Thus, when the user recall a previous examination record, the interactive program constructs the examination screen as previously displayed, with each selected procedure button colored, with the procedure drawing highlighted according to the selected procedures and the corresponding textual description of the selected procedures displayed in the procedure screen field (FIG. 3D). The interactive program is able to reproduce each examination screen in this manner by storing the specifics of each system variable to a corresponding data field in the examination record stored on the hard disk” (Dorne; column 16, lines 20-21, 48-61)

as teaching “to thereby document the patient encounter.”

At lines 10-14 on page 9 of the 20 December 2005 response, Applicant argues that the Dorne reference fails to disclose recited limitations in amended claim 84 because in the Dorne reference “the claimed ordering of diagnosis codes are all associated with the same procedure of the same patient encounter.” Examiner respectfully disagrees. Examiner interprets Dorne’s teachings of “the user enters the procedures that were involved during the patient examination” (emphasis added) (Dorne; column 11, lines 31-32) and “[t]he interactive program repeats this routine until it has stored the raw codes for all selected procedures in the designated system

Art Unit: 3626

variables (Dorne; column 12, lines 17-19) to teach that codes for multiple procedures are stored; and Examiner interprets Dorne's teaching of "it is understood that the interactive program could alternatively place the intermediate codes first in a local variable, act upon the codes and then place the final codes in a ranked order into the Final Code system variable" (emphasis added) (Dorne; column 12, lines 45-49) as teaching "rank ordering of the selection of the at least one diagnosis code linked to the selection of the patient procedure code," as recited in amended claim 84.

At the paragraph bridging pages 9-10 of the 20 December 2005 response, Applicant argues that the applied references fail to disclose recited limitations in recited claim 98. Examiner respectfully disagrees, noting that Dorne teaches "the user can save the examination data record. To save the examination data, the user clicks on a SAVE hotword 168 in the top field 150 of the screen display, as shown in FIG. 3A. This will store the examination data on the hard disk, creating a unique examination record for the particular patient examination" (Dorne; column 8, lines 11-16). Furthermore, Examiner notes that in Figure 9F, items 364 and 368 Dorne teaches "ranking" or "sort[ing] CPT [procedure] codes" and, following this ranking procedure, as shown in Figure 9G, Item 372, Dorne teaches retrieving "all ICD9 diagnostic codes likely to be associated with [the] selected procedures," followed by, in Item 388, storing in memory, or saving (i.e. maintaining) all system variable fields. Examiner interprets these teachings, together with Dorne's teachings of "keeping track of the ICD-9 diagnostic codes most likely associated with the procedures selected by the user," (Dorne; column 16, lines 9-22, column 12, lines 46-50) to read on "maintaining a rank ordered relationship between the patient procedure code and

Art Unit: 3626

the at least one diagnosis code to thereby provide a detailed record of an encounter” and as such, as teaching the argued limitations.

At paragraph 2 on pages 10 of the 20 December 2005 response, Applicant argues that the applied references fail to disclose recited limitations in amended claim 92. These limitations have been previously discussed in this Office Action.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references, Dang, U.S. Patent Number 6, 370, 511 and Heinze, et al., U.S. Patent Number 6, 915, 254, teach the environment of associating codes with medical services.

11. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: (571) 273-8300.

Art Unit: 3626

For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Natalie A. Pass

February 22, 2006


ALEXANDER KALINOWSKI
SUPERVISORY PATENT EXAMINER